

REMARKS

At the time of the Office Action, Claims 15-19 and 21-29 were pending in this Application. Claims 15-19 and 21-29 were rejected. Claims 15, 21, and 29 have been amended to further define various features of Applicants' invention. Claims 30-32 have been added.

Priority

Applicants submit a certified copy of foreign priority to prior application PCT/GB03/01606 and prior British patent application GB 0208667.6.

Rejections under 35 U.S.C. § 112

Claims 21-28 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action states that "said guidewire" of Claim 21 lacks antecedent basis. Applicants observe that claim 22 and not claim 21 recites the term "guide wire". Additionally, claim 22 depends from claim 16. Claim 16 introduces the term "guide wire" and as such, provides proper antecedent basis. Reconsideration and withdrawal of the rejections of claims 21-28 based on section 112 is requested.

Rejections under 35 U.S.C. § 102

Claims 15-19 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by Chervitz et al. (U.S. Patent No. 6,499,486).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 *citing* Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

Claim 15 recites a claim limitation that is not disclosed in Chervitz. In particular, claim 15 recites the transverse tunnel terminates within the femur bone body. This is a notable distinction because this step preserves bone mass. It is an advance, in a sense, over the procedure disclosed in Chervitz. Because Chervitz does not disclose all claim limitations of claim 15, reconsideration and withdrawal of the rejection is requested.

Claims 21-23 and 25-28 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by Howell et al. (U.S. Patent No. 5,674,224).

Claim 21 recites an additional and discrete section that is not present in Howell. In particular, claim 21 recites a nose section, a head section, an abutment surface, and a proximal body section. Howell lacks one of these sections no matter how you construe each of the sections because each section is different and adapted to provide a benefit to the procedure. The nose section, for example, may have a tapered or frustoconical shape; the head section holds or axially supports the ligament; the abutment surface (to be distinguished from the head section) urges the ligament against the bone; and the proximal body section may include a means to lock the device in the bone such as, for example, threads.

The invention recited in claim 21 includes at least one limitation that is not disclosed in Howell. At best, Howell provides a nose section (48), a head section, and a proximal body section (50). Howell, in this example lacks the abutment section. However, should Howell be construed to have an abutment section, Howell then lacks the head section. In any case, Howell does not appear to disclose all claim limitations of claim 21. Reconsideration and withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 24 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Howell et al. (U.S. Patent No. 5,674,224).

A proper *prima facie* case of obviousness under Section 103 requires, amongst other things, that the reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2142. In this instance, Howell does not disclose or suggest the passing step to follow the locating step. In contrast, Howell teaches placing the transverse screw first, then manipulating the ligament around the screw. See Howell at col. 7, line 15.

Applicants submit that there is no suggestion to carry out the method as claimed. In particular, the order of the steps as recited in claim 29 is different than that described or suggested in Howell. Reconsideration and withdrawal of the rejection of claim 29 is requested

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CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 408.735.6323.

Respectfully submitted,



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Enclosures: 1) Certified Copy Priority Application PCT/GB03/01606
2) Certified Copy Priority Application GB 0208667.6